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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte SHUUICHI YATABE
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13 Appeal 2008-2135
14 Application 10/600,834
15 Technology Center 3600
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19 Oral Hearing Held: October 22, 2008
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23 Before MURRIEL C. CRAWFORD, HUBERT C. LORIN, and STEVEN
24 D.A. McCARTHY, Administrative Patent Judges
25

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27 ON BEHALF OF THE APPELLANT:
28

29 JOHN PRETA, ESQUIRE
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35 The above-entitled matter came on for hearing on Wednesday, October 22,
36 2008, at the U.S. Patent and Trademark Office, 600 Dulany Street,
37 Alexandria, Virginia, before Virginia Johnson, Freestate Reporting, Inc.

PROCEEDINGS

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MS. BEAN: Calendar Number 19, Mr. Preta.

JUDGE CRAWFORD: Good morning.

MR. PRETA: Good morning.

JUDGE CRAWFORD: So we had a time -- some time to discuss the case, and you can begin whenever you're ready.

MR. PRETA: Okay, I'd like to focus on, on the, the last two -- the last three main lines of Claim 1 and specifically the third to last and the second to last, and it starts with the attaching B portion on Claim 1.

JUDGE CRAWFORD: Um-hum.

MR. PRETA: And that's the first feature I want to discuss, and the second would be that annular recessed portion language. If you, if you look at that language, it says that the attaching B portion which is the -- at the very end of the -- that flexible boot that's in the brake booster, that's being gripped or pinched and we say tightly held between a pair of cylindrical holding portions.

So you need two cylindrical portions holding, you know, tightly holding that end. And then those portions have to be formed by a pair of out-holders which are both attached to the cylinder, which is just another word for secured to that inside valve cylinder, which is Item 10.

And, and engaging the inner -- an inner circumferential face of the valve cylinder so you have to have two things that are attached and engaging that inner circumferential surface --

1 JUDGE CRAWFORD: Well, now the Examiner doesn't agree with
2 you.

3 MR. PRETA: Yeah --

4 JUDGE CRAWFORD: I mean, it doesn't say each engaging an inner
5 circumferential face.

6 MR. PRETA: But it says a pair of valve holders. If, if you have a
7 pair, which is just another way of saying two, that are attached and engaging
8 -- in fact, we -- when the Examiner first applied this reference, we added the
9 -- that last language that says and engaging the inner circumferential face of
10 the valve cylinder to make it clear that, that, you know, that it's one thing to
11 interpret that there -- the pair is attached, you know, because if you called
12 them a unit and attach them, but it's another thing to say that they both
13 engage.

14 So, you know, the, the, you know, when you, when you argue
15 something on the record and it's entirely consistent with all you
16 embodiments and you, you say it
17 -- you know, you always argue it, it's kind of we would argue improper for
18 the Examiner to say, I don't care how you say it, I'm still going to interpret
19 it this way.

20 You know, we've, we've established for the record that we mean both
21 contact that inner circumferential surface.

22 JUDGE CRAWFORD: Well he's really constrained by what you're
23 claiming. Well --

24 JUDGE CRAWFORD: And your claim doesn't say each engaging.

25 MR. PRETA: Under the Examiner's interpretation if we just said one
26 of the valve members attached and engaging and a pair attaching and

1 engaging, he would say that's the same thing. Well that doesn't make any
2 sense. I mean, there has to be a difference between one of them contacting
3 and attached, and a pair contacting and attached.

4 Otherwise, you know, you're -- it's kind of you're ignoring what the
5 language actually says. And the -- so, I mean we would just -- we just
6 completely disagree with that. It's, you know -- we've established for the
7 record what, what is meant by the term all the embodiments have that
8 feature. We've, we've added that in response to this rejection. I mean, it's
9 couldn't be any clearer that that's what it means.

10 As far as the second feature -- unless you have any other questions on
11 that first feature.

12 JUDGE CRAWFORD: No, go ahead.

13 MR. PRETA: Second feature, it says an annular recessed portion and
14 an annular protruding portion of the pair of cylindrical holding portions are
15 elastically engaged with each other. Now that's -- we would argue again it's
16 completely lacking in Figure 4 of Suzuki. Now it's difficult to see from the
17 rejection what exactly the Examiner is calling what, but there are hints from
18 language in, in the rejection that he means if you look at Figure 4 of Suzuki,
19 at 131B it looks like -- kind of like this. It has like a little bent portion up
20 and then straight and another bent portion, that back member. I think he's
21 calling maybe the top wing a projecting portion.

22 But again, the -- that may or may not be a good, a good choice, you
23 know, under -- if that's all we said, you know, that might be a good
24 argument, but then where's this -- where's the annular recess? You know,
25 there's no annular recess. An annular recess is a ring shaped recess, as
26 everyone knows, and we don't see any recess.

1 Now if the Examiner believes that that inner cylindrical surface of 131A is a
2 recess, that's a good argument except that we say annular recess.

3 Now the difference between a disk, which is a circle, that recess
4 in 131A would be filled with a
5 circle, right, if you put a disk in there because it's just a big opening. But an
6 annular recess actually has to have -- it actually has to be ring-shaped, you
7 know, because the word annular means ring-shaped, and there's nothing --
8 you know, there's a difference -- again, there's a difference between a disk
9 and a ring. You know, a disk has its entire center filled with whatever it is.
10 It's a disk, like a plate. But a ring has, has nothing in the center and it's
11 basically defined by its ring shape. So there's -- so, you know, at the, you
12 know, the combination of the two features missing -- I think the Examiner
13 has conflated the, you know, this reference which, you know, which is
14 relevant because it's, it's talking about the same thing as us, but those very
15 details are just missing. And, you know, it's compounded by the fact that
16 they're both talking about the same two, or pair of, members. That would be
17 our point.

18 And, you know -- and just -- and then, you know -- and then it, it
19 further says that again -- it could actually consider a third distinction, and
20 that is these two annular things are elastically engaged, and that's, that's just
21 tough again to see because the Examiner's argument at 29B is the thing
22 that's causing the elastic engagement.

23 But if you look at the reference, 131B is pressed in to 131A, so let's
24 assume that we take the language of this reference as a given, right, press a
25 metal ring inside another metal thing. When you press it in, it obviously
26 requires a force and it's probably stationary which I -- which is exactly what

1 it's designed to do because it's designed to press up against that, that, that
2 would-be end of that rubber thing and actually make an airtight seal. So it
3 makes sense to push it up nice and tight.

4 Well it's doubtful that that spring would do anything about -- with
5 regard to elastic engagement once that thing is pressed into the ring, so I,
6 you know -- in, in assuming that it does, you know -- first off we would
7 argue that's speculation, you know. There's nothing, there's nothing about
8 the -- I mean, the spring is not designed to do that. It's just designed to just
9 stay there and push back on the rod that goes to the brake pedal, you know,
10 to move it back to an original position. That's the whole purpose of that
11 spring. There's nothing in this, in this document about using that to create
12 any kind of, you know, extra sealing between the two members or any kind
13 of elastic deflection.

14 So I mean, I think, though, you know, those three differences are, are
15 very significant with regard to Figure 4 of Suzuki.

16 JUDGE CRAWFORD: Okay. You have questions?

17 JUDGE LORIN: No.

18 JUDGE CRAWFORD: Any questions? Thank you.

19 MR. PRETA: Do you want my card or --

20 JUDGE CRAWFORD: Court reporter.

21 (Whereupon, the proceedings concluded on October 22, 2008.)